

REMARKS

Claims 1, 2, 4 through 7, 9 and 10 are pending in this application. Claims 1, 2, 4 through 7, 9 and 10 have been amended and claims 3, 8 and 11 cancelled. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present amendment should be apparent throughout the originally filed disclosure, noting that the limitations of claim 3 have been incorporated into claim 2, the limitations of claim 8 have been incorporated into claim 7 and that the limitations of claim 11 have been incorporated into claim 10. Applicants submit that the present amendment does not generate any new matter issue.

Claims 1 through 11 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Ofuji et al.

In the statement of the rejection the Examiner referred to various portions of Ofuji et al., asserting the disclosure of inventions corresponding to those claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.* 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed inventions and the disclosure of Ofuji et al. that scotch the factual determination that Ofuji et al. disclose a base station, communication system, channel allocating method or computer executable program identically corresponding to those claimed.

Specifically, independent **claim 1** is directed to a base station apparatus which determines a modulation method for communication with a terminal apparatus. Significantly, claim 1 specifies that permissible delay time in data communication corresponding to an application used in a terminal apparatus is used as a criterion for determination. No such concept is disclosed or suggested by Ofuji et al.

Indeed Ofuji et al. disclose an apparatus in which channels are allocated in accordance with the transmission path situation priority. The order observed in assigning channels to a terminal apparatus is controlled. However, Ofuji et al. neither disclose nor suggest the concept of determining a modulation method as set forth in independent **claim 1**.

Claim 2 depends from claim 1 and distinguishes over Ofuji for reasons advocated with respect to claim 1. Moreover, Applicants separately argue the patentability of **claim 2**. Indeed, claim 2 specifies that the criterion for determination is different depending upon whether the permissible delay time is longer than a threshold value or equal to or shorter than that. If the permissible delay time is longer than the threshold value, the base station apparatus selects a modulation method capable of transmitting a relatively large amount of data in preference to the other methods, in accordance with the value indicative of the quality of the communication line. The base station apparatus then determines the number of channels in accordance with the selection of the modulation method. If the permissible delay time is equal to or shorter than the threshold value, the base station apparatus determines that the number of channels be maximized by referring to the number of unoccupied channels. The base station apparatus then selects a modulation method in accordance with the determination of a number of channels. In the former case, a relatively small number of channels are used in a modulation method capable of transmitting a relatively large amount of data. Accordingly, the number of channels available for

termination apparatuses is increased. In the latter case, a relatively large number of channels are used in a modulation method with a lower error rate. Therefore, favorable permissible delay time is ensured.

On the other hand, Ofuji et al. merely disclose unifying a plurality of individual priority before executing assignment of channels. However, Ofuji et al. neither disclose nor suggest modifying a criterion for determination depending upon the relation between permissible delay time and a threshold value as specified in claim 2.

Applicants respectfully submit that the above arguments set forth with respect to the patentability of claim 1 apply equally to the patentability of claims 4, 5, 6 and 9, the patentability of each of which claim is separately argued. Applicants further submit that the arguments advanced with respect to the patentability of claim 2 applied equally to the patentability of claims 7 and 10, the patentability of which claims is separately argued.

The above argued differences between the claimed inventions and the disclosure of Ofuji et al. undermine the factual determination that Ofuji et al. disclose a base station apparatus, communication system, channel allocating method, or computer executable program identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 11 under 35 U.S.C. § 102 for lack of novelty as evidenced by Ofuji et al. is not factually viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Arthur J. Steiner', is written over the printed name.

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